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| 10/058,189 | 01/29/2002 | Jonathan Goldstone | Q63477 | 3944 |

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| EXAMINER | |
|---|---|
| POKRZYWA, JOSEPH R | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2625 | |

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/058,189 | GOLDSTONE, JONATHAN | |
| | Examiner | Art Unit | |
| | Joseph R. Pokrzywa | 2625 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *10 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment was received on 5/10/06, and has been entered and made of record. Currently, **claims 1-29** are pending.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-29** are rejected under 35 U.S.C. 102(e) as being anticipated by Little *et al.* (U.S. Patent Application Publication 2005/0009502) .

Regarding ***claim 1***, Little discloses an electronic message retrieval system (see abstract) comprising a sender operable to transmit an encrypted electronic message, directed to a mobile device of a specified recipient, over a transmission medium (paragraphs 0046-0055); a message retrieval device associated with the specified recipient operable to receive the encrypted electronic message and provide a notification message to the mobile device indicating receipt of the encrypted electronic message by the message retrieval device (paragraphs 0051-0059); wherein the mobile device being operable to receive the notification message from said message retrieval device and in response thereto provide a secret password to said message retrieval

device to initiate decryption of the encrypted electronic message (paragraphs 0051-0059), wherein said message retrieval device is further operable to convert the decrypted electronic message into a format that is compatible with the mobile device, and to transmit the converted decrypted electronic message to the mobile device (paragraphs 0051-0064).

Regarding ***claim 2***, Little discloses the system discussed above in claim 1, and further teaches that the format includes at least one of an audible format, a facsimile format, and a text format (paragraphs 0060-0062, 0082, and 0119-0120).

Regarding ***claim 3***, Little discloses the system discussed above in claim 1, and further teaches that the message retrieval device comprises a converter device operable to convert the format of the decrypted electronic message into a format recognized by the mobile device; and an output unit from which the converted decrypted electronic message is provided to the mobile device (paragraphs 0051-0066).

Regarding ***claim 4***, Little discloses the system discussed above in claim 3, and further teaches that the sender encrypts the electronic message in accordance with a specified electronic key and said message retrieval device decrypts the encrypted electronic message using said specified electronic key (paragraphs 0051-0066).

Regarding ***claim 5***, Little discloses the system discussed above in claim 1, and further teaches of a password transmission unit operable to transmit a password to said specified recipient (paragraphs 0051-0066).

Regarding ***claim 6***, Little discloses the system discussed above in claim 5, and further teaches of a password transmission path through which the secret password is transmitted to said recipient's mobile device, and a message transmission path, different from said password

transmission path, through which said decrypted electronic message is provided to the recipient's mobile device (paragraphs 0051-0066).

Regarding ***claim 7***, Little discloses the system discussed above in claim 6, and further teaches that the password is generated by the sender and communicated to the password transmission unit in a message different from the encrypted electronic message (paragraphs 0051-0066).

Regarding ***claim 8***, Little discloses the system discussed above in claim 1, and further teaches that the mobile device is a cell phone that is unable to decrypt the encrypted electronic message (paragraphs 0030-0033, and 0119-0124), and wherein the portion of the transmission medium is the Internet (paragraphs 0026-0033).

Regarding ***claim 9***, Little discloses the system discussed above in claim 1, and further teaches that the encrypted electronic message comprises an indication as to whether the encrypted electronic message can be converted into a different format (paragraphs 0060-0062, 0082, and 0119-0120).

Regarding ***claim 10***, Little discloses an electronic message retrieval system (see abstract) comprising a sender operable to transmit an encrypted electronic message to a mobile device of a specified recipient that is unable to decrypt the encrypted electronic message (paragraphs 0046-0055), a message retrieval device operable to receive the encrypted electronic message and provide a notification message to the mobile device when the encrypted electronic message is received by the message retrieval device (paragraphs 0051-0059), wherein said mobile device is operable to receive messages in a format different from the format of the encrypted electronic message (paragraphs 0051-0064), said message retrieval device comprising a decryption device

operable to decrypt the encrypted electronic message upon receipt of a password from the mobile device (paragraphs 0051-0064); a converter device operable to convert the decrypted electronic message into a format recognized by the mobile device (paragraphs 0051-0064), said electronic message retrieval system further comprising a secure device operable to receive and decrypt the encrypted electronic message (paragraphs 0051-0064), wherein said secure device is operable to receive messages in the same format as the format of the encrypted electronic message (paragraphs 0051-0064).

Regarding ***claim 11***, Little discloses an electronic message retrieval method comprising in response to receiving an encrypted electronic message (paragraphs 0051-0055), notifying a recipient's mobile device of the encrypted electronic message, the recipient's mobile device being unable to decrypt the encrypted electronic message (paragraphs 0051-0055, and 0060-0066); determining, based on instructions from the recipient's mobile device whether to decrypt the encrypted electronic message (paragraphs 0060-0066) and whether to have the decrypted electronic message converted into a format that is compatible with the mobile device (paragraphs 0060-0066).

Regarding ***claim 12***, Little discloses the system discussed above in claim 11, and further teaches of providing a password to a message retrieving device of the recipient to render the message retrieving device operable to decrypt the encrypted electronic message (paragraphs 0051-0066), and converting the decrypted electronic message into a format compatible with the mobile device from a format which is incompatible with the mobile device (paragraphs 0051-0066).

Regarding ***claim 13***, Little discloses the system discussed above in claim 11, and further teaches of indicating to said recipient's mobile device whether the decrypted electronic message can be converted into a format compatible with the mobile device from a format which is incompatible therewith (paragraphs 0060-0062, 0082, and 0119-0120).

Regarding ***claim 14***, Little discloses an electronic message retrieval method comprising sending an encrypted electronic message over a communication network to a recipient's message retrieving device (paragraphs 0046-0055); notifying a recipient's mobile device of receipt of the encrypted electronic message (paragraphs 0051-0059); determining whether to defer retrieval of the encrypted electronic message or retrieve the encrypted electronic message immediately on the recipient's mobile device (paragraphs 0051-0066); and if it is determined that retrieval of the encrypted electronic message is to be deferred, receiving and decrypting said encrypted electronic message on a secure machine associated with the recipient (paragraphs 0051-0066); or if it is determined that retrieval of the encrypted electronic message is to be performed immediately, providing a password to the recipient's message retrieving device to render the recipient's message retrieving device operable to decrypt the encrypted electronic message (paragraphs 0051-0064), and converting the decrypted electronic message into a format compatible that is compatible with the recipient's mobile device (paragraphs 0051-0066).

Regarding ***claim 15***, Little discloses an electronic message retrieval system (see abstract) comprising sender operable to transmit an encrypted electronic message over communication network directed to a specified recipient's mobile device that is unable to decrypt the encrypted electronic message (paragraphs 0046-0055), a message retrieval device operable to receive the encrypted electronic message and provide a notification message to the mobile device when the

encrypted electronic message is received by the message retrieval device (paragraphs 0051-0059), a proxy device operable to receive the encrypted electronic message from the message retrieval device when the recipient's mobile device provides a proxy instruction to said message retrieval device and operable to decrypt and transmit a decrypted electronic message to said recipient's mobile device when the recipient provides a password to said proxy device (paragraphs 0051-0066).

Regarding ***claim 16***, Little discloses the system discussed above in claim 3, and further teaches of a secure device operable to receive and decrypt the encrypted electronic message, wherein said secure device is operable to receive messages in the same format as the format of the decrypted electronic message (paragraphs 0051-0066, 0082, and 0119-0120).

Regarding ***claim 17***, Little discloses the system discussed above in claim 3, and further teaches that the said encryption is performed by the sender using a publicly accessible key associated with the recipient (paragraphs 0051-0066).

Regarding ***claim 18***, Little discloses the system discussed above in claim 15, and further teaches that said proxy decrypts said encrypted electronic message by using a private key securely stored on said proxy (paragraphs 0051-0066).

Regarding ***claim 19***, Little discloses the system discussed above in claim 3, and further teaches that said mobile device is operable to receive messages in a format different from the format of the decrypted electronic message (paragraphs 0051-0066).

Regarding ***claim 20***, Little discloses the system discussed above in claim 15, and further teaches that the proxy device comprising a decryption device operable to decrypt an encrypted private key associated with the recipient and also decrypt the encrypted electronic message,

wherein the decryption device is activated upon receipt of a password (paragraphs 0051-00660082, and 0119-0120) and a converter device operable to convert the decrypted electronic message into a format recognized by the mobile device (paragraphs 0051-00660082, and 0119-0120).

Regarding ***claim 21***, Little discloses an electronic message retrieval system (see abstract and Figs. 1-3) comprising a sender operable to transmit an encrypted electronic message over communication network directed to a specified recipient's mobile device (paragraphs 0046-0055), wherein said encryption is performed using a publicly accessible key associated with the recipient (paragraphs 0046-0055), a message retrieval device operable to receive the encrypted electronic message and provide a notification message to the recipient's mobile device when the encrypted electronic message is received by the message retrieval device (paragraphs 0051-0059), wherein said recipient's mobile device is operable to receive messages in a format different from the format of the encrypted electronic message received by the message retrieval device (paragraphs 0051-0059); a proxy device operable to receive the encrypted electronic message from the message retrieval device when the recipient provides a proxy instruction (paragraphs 0051-0059), said proxy device comprising a decryption device operable to decrypt an encrypted private key associated with the recipient and also decrypt the encrypted electronic message, wherein the decryption device is activated upon receipt of a password (paragraphs 0051-0066), and a converter device operable to convert the decrypted electronic message into a format recognized by the mobile device (paragraphs 0051-0066), and said electronic message retrieval system further comprising; a secure device operable to receive and decrypt the encrypted electronic message (paragraphs 0051-0066), wherein said secure device is operable to

receive messages in the same format as the format of the encrypted electronic message (paragraphs 0051-0066).

Regarding ***claim 22***, Little discloses the system discussed above in claim 21, and further teaches of a third party authority operable to receive said encrypted electronic message from said proxy device and decrypt the encrypted electronic message using a public key corresponding to said proxy device (paragraphs 0051-0066).

Regarding ***claim 23***, Little discloses the system discussed above in claim 22, and further teaches that said third party authority is located in a legal jurisdiction other than a legal jurisdiction in which said recipient's mobile device is located (paragraphs 0051-0066).

Regarding ***claim 24***, Little discloses the system discussed above in claim 22, and further teaches that said third party authority is operable to receive a reference designation corresponding to said encrypted electronic message along with said encrypted electronic message (paragraphs 0051-0066).

Regarding ***claim 25***, Little discloses the system discussed above in claim 24, and further teaches that said third party authority is operable to receive said reference designation corresponding to said encrypted electronic message from said specified recipient and said decryption of said encrypted electronic message is controlled in accordance with the reference designation received from said specified recipient (paragraphs 0051-0066).

Regarding ***claim 26***, Little discloses an electronic message retrieval method comprising sending an encrypted electronic message over a communication network to a recipient's message retrieving device (paragraphs 0046-0055), wherein said encryption is performed using one of a plurality of publicly accessible keys associated with the recipient (paragraphs 0046-0055);

alerting the recipient's mobile device of the receipt of the encrypted electronic message (paragraphs 0051-0059); determining, based on a message from the recipient's mobile device whether to defer retrieval of the encrypted electronic message or retrieve the encrypted electronic message immediately (paragraphs 0051-0066); and if it is determined that retrieval of the encrypted electronic message is to be deferred, receiving and decrypting said encrypted electronic message on a secure machine associated with the recipient (paragraphs 0051-0066); or if it is determined that retrieval of the encrypted electronic message is to be performed immediately, providing one of a plurality of passwords to a proxy device (paragraphs 0051-0066); decrypting, in said proxy device, a private encrypted key associated with the recipient to render the proxy operable to decrypt the encrypted electronic message (paragraphs 0051-0066); and converting the electronic message into a format compatible with the recipient's mobile device from a format which is incompatible with the recipient's mobile device (paragraphs 0051-0066).

Regarding ***claim 27***, Little discloses an electronic message retrieval system (see abstract and Figs. 1-3) comprising a sender operable to transmit encrypted electronic message over a communication network directed to a specified recipient's mobile device (paragraphs 0046-0055), wherein said encryption is performed using one of a plurality of publicly accessible keys associated with the recipient (paragraphs 0046-0055); a message retrieval device operable to receive the encrypted electronic message and provide a notification message to the recipient's mobile device when the encrypted electronic message is received by the message retrieval device (paragraphs 0051-0059), wherein said recipient's mobile device is operable to receive messages in a format different from the format of the encrypted electronic message (paragraphs 0051-

0066); a proxy device operable to receive the encrypted electronic message from the message retrieval device when the recipient provides a proxy instruction (paragraphs 0051-0066), said proxy device comprising a decryption device operable to decrypt a plurality of encrypted private keys associated with the recipient and also decrypt the encrypted electronic message (paragraphs 0051-0066), wherein the decryption device is activated upon receipt of one of a plurality of passwords respectively associated with said encrypted private keys (paragraphs 0051-0066); a converter device operable to convert the electronic message into a format recognized by the recipient's mobile device (paragraphs 0051-0066); said electronic message retrieval system further comprising a secure device operable to receive and decrypt the encrypted electronic message (paragraphs 0051-0066), and wherein said secure device is operable to receive messages in the same format as the format of the encrypted electronic message (paragraphs 0051-0066).

Regarding ***claim 28***, Little discloses an electronic message retrieval method comprising

sending an encrypted electronic message over a communication network to a recipient's message retrieving device (paragraphs 0046-0055), wherein said encryption is performed using one of a plurality of publicly accessible keys associated with the recipient (paragraphs 0046-0055); alerting the recipient's mobile device of the receipt of the encrypted electronic message (paragraphs 0051-0059); determining, based on instructions from the recipient whether to defer retrieval of the encrypted electronic message or retrieve the encrypted electronic message immediately (paragraphs 0051-0066); and if it is determined that retrieval of the encrypted electronic message is to be deferred, receiving and decrypting said encrypted electronic message on a secure machine associated with the recipient (paragraphs 0051-0066); or if it is determined

that retrieval of the encrypted electronic message is to be performed immediately, providing one of a plurality of passwords to a proxy device, said provided password being associated with the publicly accessible key used to encrypt the message (paragraphs 0051-0066); decrypting, in said proxy device and upon receipt of said password, a private encrypted key associated with the publicly accessible key used to encrypt the message to render the proxy operable to decrypt the encrypted electronic message (paragraphs 0051-0066); and converting the electronic message into a format compatible with the recipient's mobile device from a format which is incompatible with the recipient's mobile device (paragraphs 0051-0066).

Regarding ***claim 29***, Little discloses an electronic message retrieval system (see abstract and Figs. 1-3) comprising sender operable to transmit an encrypted electronic message, directed to a specified recipient's mobile device, over a transmission medium (paragraphs 0046-0055); the recipient's mobile device being unable to decrypt the encrypted electronic message (paragraphs 0046-0066), a message retrieval device operable to receive the encrypted electronic message and provide a notification message to the recipient's mobile device indicating that the encrypted electronic message has been received by the message retrieval device, and to decrypt the encrypted electronic message (paragraphs 0051-0066); and wherein the recipient's mobile device is operable to receive said decrypted electronic message from said message retrieval device in a format that is different from a format of the encrypted electronic message (paragraphs 0051-0066).

***Citation of Pertinent Prior Art***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**Picoult *et al.*** (U.S. Patent Number 6,654,601) discloses a system for remote retrieval of messages; and

**Asthana *et al.*** (U.S. Patent Application Publication 2004/0185877) discloses a system for managing message attachments for mobile data communication.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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